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No. 00-1543

In the
Supreme Court of the United States

FESTO CORPORATION,
PETITIONER,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., A/K/A/ SMC CORPORATION AND SMC PNEUMATICS, INC.,
RESPONDENTS.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR MINNESOTA MINING AND MANUFACTURING COMPANY ET AL. AS *AMICI CURIAE* IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

GARY L. GRISWOLD
Counsel of Record
MINNESOTA MINING AND MANUFACTURING COMPANY
P.O. Box 33427
St. Paul, Minnesota
55133-3427
(651) 733-8904

25 pp

QUESTIONS PRESENTED

The questions presented by the Petitioner are:

1) Whether every claim-narrowing amendment designed to comply with any provision of the Patent Act—including those provisions not related to prior art—automatically creates prosecution history estoppel regardless of the reason for the amendment; and

2) Whether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents.

AMICI CURIAE JOINING THIS BRIEF

Minnesota Mining and Manufacturing Company

Bose Corporation

The Dow Chemical Company

Henkel Corporation

Johnson & Johnson

Pfizer Incorporated

PPG Industries, Incorporated

Rexam Beverage Can Company

Sun Microsystems, Incorporated

Verizon Communications Incorporated

The parent corporations of the Henkel Corporation are Henkel of Americas and Henkel KGaA. The parent corporation of the Rexam Beverage Can Company is Rexam PLC. No other publicly held company owns 10% or more of the stock in these corporations.

The Minnesota Mining and Manufacturing Company, Bose Corporation, The Dow Chemical Company, Johnson & Johnson, Pfizer Incorporated, PPG Industries, Incorporated, Sun Microsystems, Incorporated, and Verizon Communications Incorporated have no parent corporations, and no publicly held company owns 10% or more of the stock in these corporations.

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INTEREST OF THE *AMICI CURIAE*

The *Amici Curiae* are American corporations of various sizes, involved in a variety of different businesses.[1] Some of them obtain relatively large numbers of United States patents every year (*e.g.*, 3M obtained 483 U.S. patents in 2000; Sun Microsystems obtained 465); some of them obtain far fewer. But what brings them together as *Amici Curiae* is their shared belief in the importance of investments in research and development, and their desire for a patent system that justifies those investments by providing effective protection for their innovations against copying and infringement. In many respects, therefore, the *Amici Curiae* represent a cross section of typical users of the United States patent system.

In seeking U.S. patents to protect the fruits of their investment in research and development, the *Amici Curiae* have come to rely on the scope that their patent rights have enjoyed under the case law of this Court and the United States Court of Appeals for the Federal Circuit. The doctrine of equivalents has been an integral part of the rights that typical patent owners have relied upon under the patent laws since this Court's decision in 1854 in *Winans v. Denmead*, 56 U.S. 330, 15 How. 330, 14 L. Ed. 717. The doctrine of equivalents has afforded patent owners with effective protection from infringers who

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[1] The parties have consented to the filing of this brief, and letters of consent are being filed herewith. In accordance with Supreme Court Rule 37.6, the *Amici Curiae* represent that no counsel for a party authored this brief in whole or in part and no person or entity, other than the *Amici Curiae*, their members, or their counsel made a monetary contribution to the preparation or submission of this brief.

make merely insubstantial differences from the literal language of patent claims. Such protection has been absolutely crucial to companies who seek to protect their core technology through patent rights, but who cannot predict, much less patent, each and every insubstantial difference or nuance a copyist might make to avoid the literal claim language.

The *Amici Curiae* believe that the decision of the United States Court of Appeals for the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000) (*en banc*), is inconsistent with the well-settled body of precedent they have come to rely upon, including from this Court in its decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997).

Moreover, by ruling now that prosecution history estoppel automatically applies to bar ***any*** range of equivalents to ***any*** claim element that was in any sense narrowed by amendment during prosecution for virtually ***any*** reason,[2] the Federal Circuit has unfairly changed the rules with respect to vast numbers of patents already in force, and to be granted in the future, in a manner that the *Amici Curiae* believe seriously undermines the patent

[2] As discussed in Section I, *infra*, the Federal Circuit, in holding in *Festo* that any "narrowing" amendment made for a substantial reason related to "patentability" triggers prosecution history estoppel, defines "patentability" far more broadly than this Court did in *Warner-Jenkinson*, leaving little possibility of an amendment that would not automatically bar the doctrine of equivalents.

system and its ability to encourage investments in innovation.[3]

SUMMARY OF THE ARGUMENT

When this Court decided in *Warner-Jenkinson* that the doctrine of equivalents should remain a vital component of patent law, its opinion assured that inventors would be afforded reasonable and appropriate protection against infringers. This Court recognized that inventions should be protected from those seeking to free ride on inventive efforts by practicing mere *insubstantial differences* from the claimed invention. In essence, this Court quite appropriately recognized that a fundamental property right—innovations just outside the literal scope of a patent claim, but nonetheless equivalent to the claimed invention—should belong to the innovator, rather than to the copyist.

The Federal Circuit's *en banc* decision in *Festo* has eviscerated that property right. The Federal Circuit has grafted onto the doctrine of equivalents a wide-ranging and indiscriminate prosecution history estoppel that works to restrict patent claims to their literal scope in virtually all but those rare situations in which a "virgin" claim—never tarnished by a narrowing amendment during the give-and-take of prosecution before a patent examiner—remains in the issued patent. In effect, the Federal Circuit's *Festo* decision all but eliminates the doctrine of

[3] The importance of the Federal Circuit's decision and its impact on patent law are further underscored by the fact that the Court of Appeals heard this case *en banc* and received many *amicus curiae* briefs, including ones from industry representatives Hewlett-Packard, Procter & Gamble, IBM, Ford, and Kodak.

equivalents as a means of protecting the fruits of innovation.

The reach of prosecution history estoppel that the Federal Circuit adopts in *Festo* is contrary to the settled expectations arising from over a century of this Court's precedent, culminating in *Warner-Jenkinson*, *see* Judge Michel's partial dissent in *Festo*, *id.* at 601-09, and eighteen years of Federal Circuit precedent. *See id.* at 612-15. The Federal Circuit's decision in substance negates this Court's holding in *Warner-Jenkinson*.

The *Amici Curiae* believe that the Federal Circuit, in an effort to set out "bright line" rules, elevates certainty over fairness. The *Amici Curiae* believe that this "solution" is worse than the perceived "problem." The decision in *Festo* violates fundamental fairness, by wiping out long-standing precedent on which the owners of over one million U.S. patents now in force relied in prosecuting their applications, in effect constituting a retroactive legislative elimination of basic property rights in those patents. The decision is also likely to saddle the prosecution of patent applications with increased contentiousness, cost, and delay, thus undermining the future effectiveness of the patent system as an incentive for investments in new technology.

This Court's mandate in *Warner-Jenkinson* made clear that the doctrine of equivalents is a fundamental part of the patent grant: "Today we adhere to the doctrine of equivalents." 520 U.S. at 41. The Federal Circuit's *Festo* decision narrows the doctrine of equivalents to the point where it no longer serves as an effective, enforceable means to protect the property rights inherent in the patent grant. Thus, grant of *certiorari* is needed to reverse the Federal Circuit's holding and restore the reach of

the doctrine of equivalents as mandated in *Warner-Jenkinson*.

ARGUMENT

I. *Warner-Jenkinson* Stands For A Balanced, Rather Than A Bright Line, Approach To The Doctrine Of Prosecution History Estoppel.

The doctrine of equivalents is a judicial doctrine at its heart calculated to produce fundamental fairness. This fairness cannot exist absent a balanced, case-by-case judgment of where the equities lie—in the public's right to certainty in a patent's scope of exclusivity, or in the innovator's right to protection that is not tightly bounded by a linguistic literalism that allows mere colorable differences to escape the reach of a patent. Although the public may benefit in some respects from the increased certainty that may result from strict "bright line" literalism in construing the scope of patent rights, such benefits come at the cost of the patentee's rights, since such a framework disproportionately burdens the patentee. Thus, the doctrine of equivalents "tempers the rigor of literalness" and strengthens the patent system by evaluating the proper scope of patent protection on a case-by-case basis, rather than using an arbitrary rule. *Hilton Davis Chemical Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1531 (Fed. Cir. 1995) (*en banc*) (Newman, J., concurring), *rev'd and remanded*, 520 U.S. 17 (1997).

This Court in *Warner-Jenkinson* confirmed the vitality of the doctrine of equivalents. It then proceeded to recognize the unfairness and

disincentives created by an inflexible approach to when prosecution history estoppel arises to bar application of the doctrine of equivalents, and how the scope of an estoppel, once it arises, should be gauged.

Specifically, with respect to when an estoppel arises, this Court rejected the petitioner's proposed inflexible rule that any narrowing amendment would create an estoppel. Instead, the Court distinguished between two categories of amendments. One category consists of amendments "related to patentability," 520 U.S. at 33, which the Court noted were usually made to distinguish prior art or avoid obviousness. *See* 520 U.S. at 30-31. The second category consisted of amendments made for the "*variety* of other reasons why the PTO [Patent and Trademark Office] m[ight] request a change in claim language." 520 U.S. at 31 (emphasis added). Only amendments in the first category would necessarily give rise to an estoppel. Amendments in the second category, even though made in response to the "Patent Office's insistence upon a change in the claims," *id.*, and thus imposed as a condition of the patent grant, would "not necessarily preclude infringement by equivalents of that element." *Id.* at 33. In presenting its reasons for distinguishing between these two categories of amendments, this Court gave weight to well-settled Patent Office practices:

> And if the PTO has been requesting changes in claim language without the intent to limit equivalents or, indeed, with the expectation that language it required would in many cases allow for a range of equivalents, we should be extremely reluctant to upset the basic assumptions of the PTO without substantial reason for doing so. Our prior cases have consistently applied prosecution history estoppel only where claims have been amended for a *limited* set of reasons, and we see no substantial cause for requiring a more rigid rule invoking an estoppel regardless of the reasons for a change.

Id. at 32 (emphasis added).

For examples of amendments in the second category, the Court cited pages 22-23 of the Brief for United States as *Amicus Curiae*, which in turn described amendments relating to the requirements of 35 U.S.C. § 112: enablement, specificity, definiteness, and the like.[4] *See* 520 U.S. at 31-32. *Festo*, in contrast, sweeps *all* "narrowing" amendments into the first category, leaving little, if any, room for amendments that do not automatically trigger an absolute estoppel. In doing so, the *en banc* majority in *Festo* does not discuss this Court's treatment of amendments to overcome non-prior art rejections, including the above-quoted discussion by this Court of "the basic assumptions of the PTO" or this Court's reference to the section 112 rejections

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[4] The Brief for the United States as *Amicus Curiae* stated that amendments "to reflect the scope of what was enabled or to add specificity," in addition to "claim changes or arguments made in order to more particularly point out the applicant's invention," should "not necessarily estop" the patentee from obtaining protection under the doctrine of equivalents. Brief for the United States as *Amicus Curiae* at 22-23, 1996 WL 172221, *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17 (1997) (No. 95-728) (internal quotation marks and citation omitted). Such amendments relate to compliance with 35 U.S.C. § 112, which notably does ***not*** appear under Chapter 10 of Title 35 entitled "Patentability of Inventions."

discussed in the Brief for the United States as *Amicus Curiae*. *Id.* at 32. Rather, the Court of Appeals simply states "we do not believe that the Supreme Court itself answered this question in *Warner-Jenkinson*." *Festo*, 234 F.3d at 567. To the contrary, the *Amici Curiae* submit that *Warner-Jenkinson* does in fact stand for the proposition that section 112-related amendments, even though required by the PTO to secure issuance of a patent, are not in the category of amendments "related to patentability" that necessarily create an estoppel. *Warner-Jenkinson*, 520 U.S. at 33.

Likewise, *Warner-Jenkinson* confirmed the same "look at the reason for the amendment" approach in describing how the scope of an estoppel, once created, should be determined. Because the "scope of estoppel" question was not squarely raised in *Warner-Jenkinson*, this Court devoted less discussion to it than to the question of when an estoppel arises. Nevertheless, in footnote 7 the Court signaled that there would be no absolute bar to equivalents even when the amendment distinguished prior art and thus created an estoppel:

> We do not suggest that, where a change is made to overcome an objection based on the prior art, a court is free to review the correctness of that objection when deciding whether to apply prosecution history estoppel. As petitioner rightly notes, such concerns are properly addressed on direct appeal from the denial of a patent, and will not be revisited in an infringement action. *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. at 789-790. What *is* permissible for a court to explore is the reason (right or wrong) for the objection *and the manner in which the amendment addressed and avoided the objection.*

Id. at 33 n.7 (second emphasis added).

Thus, even with respect to amendments made to distinguish the prior art, this Court did not hold or suggest that no range of equivalents is permissible. To the contrary, a fair reading of *Warner-Jenkinson* is that, even with respect to amendments made to overcome prior art rejections, the scope of the resulting estoppel should be determined based on the real substance of what had actually happened during prosecution—the nature of the prior art objection and the rationale for how the amendment distinguished the art. Indeed, this straightforward reading of *Warner-Jenkinson* is confirmed by the Federal Circuit's own decisions issued prior to *Festo*. *See, e.g., Litton Systems, Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1455 (Fed. Cir. 1998); *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1476 (Fed. Cir. 1998); *Sextant Avionique, S.A. v. Analog Devices, Inc.*, 172 F.3d 817, 830-32 (Fed. Cir. 1999). In *Festo*, however, the *en banc* majority now rejects this uniform interpretation of *Warner-Jenkinson* set forth by several Federal Circuit panels. 234 F.3d at 569.

It also should be noted that this Court's opinion in *Warner-Jenkinson* reaffirmed several safeguards designed to protect against overbroad or unfounded application of the doctrine of equivalents. This Court: (1) limited the doctrine of equivalents to subject matter that represents only "insubstantial differences" from the literal claim language; (2) expressly recognized that the doctrine of equivalents may not be used to ignore express claim elements, but rather must be applied on an element-by-element basis (the so-called "All Elements Rule"); (3)

established a presumption that an unexplained claim amendment would give rise to prosecution history estoppel; and (4) encouraged district courts to enforce such safeguards by use of summary judgment. *See* 520 U.S. at 39, 39 n.8. These safeguards, and others that have long been recognized by the Federal Circuit, such as the limitations on the doctrine of equivalents imposed by the prior art, have provided ample opportunities for courts to enter judgments of non-infringement in cases where they are warranted. Indeed, since this Court's *Warner-Jenkinson* decision in 1997, there have been at least 48 reported decisions of the Federal Circuit involving district court grants of summary judgment of non-infringement under the doctrine of equivalents, and of those the Federal Circuit affirmed 31 (69%) of them. In short, the doctrine of equivalents is far from a legal doctrine run amok, justifying the bright line rule announced by the Federal Circuit in *Festo*.

II. The Federal Circuit's New Inflexible Rule Is In Direct Conflict With Warner-Jenkinson.

The Federal Circuit's *en banc* decision in *Festo* effectively reverses *Warner-Jenkinson*'s reaffirmation of the doctrine of equivalents. In fact, post-*Festo* district court decisions already have recognized that *Festo* leaves little room for application of the doctrine of equivalents, with virtually the only exception being those rare instances in which a patent claim sailed through prosecution without amendments. *See, e.g., Control Resources Inc. v. Delta Electronics, Inc.*, 133 F. Supp.2d 121, 134 (D. Mass. 2001) (observing that the

Festo decision "essentially stops the doctrine of equivalents in its tracks").

As explained above, the Federal Circuit's decision in *Festo* also specifically conflicts with two key aspects of this Court's decision in *Warner-Jenkinson* regarding prosecution history estoppel. First, whereas this Court made explicit that amendments made in response to section 112 rejections should be treated differently from those made to overcome prior art rejections, the Federal Circuit lumps all those amendments together. The result is that "the *variety* of other reasons why the PTO may request a change in claim language" held by this Court not necessarily to create an estoppel is now all but extinct. *Warner-Jenkinson*, 520 U.S. at 31 (emphasis added).

Second, in applying an absolute rule to the scope of an estoppel, the Federal Circuit upsets both the overall balanced approach of *Warner-Jenkinson* and the well-settled rule, reaffirmed in *Warner-Jenkinson*, that the underlying rationale for an amendment should be considered even when the amendment relates to prior art. *Id.* at 33 n. 7. A careful reading of the Federal Circuit's majority and concurring opinions in *Festo* suggests that the court's new bright line approach to the doctrine of prosecution history estoppel is designed to address the lack of complete certainty that is an inherent by-product of the doctrine of equivalents itself. As noted above, it is far from clear that such uncertainty is a pervasive problem, and there is nothing in the record of this case that demonstrates, or even suggests, that the Federal Circuit's bright line approach is necessary to remedy widespread instances of patentees resorting to the doctrine of equivalents to obtain an unfounded scope for their patent rights.

But in any event, the Federal Circuit's efforts to promote "certainty" conflict with this Court's reasoning in *Warner-Jenkinson*, which at its core held that a degree of uncertainty ***is*** an acceptable price to pay for the fairness that the doctrine of equivalents provides.

The Federal Circuit's majority opinion in *Festo* repeatedly invokes the "notice function" of patent claim language. Yet that notice function is no more undermined by a finding of equivalence to an amended claim than it is by a finding of equivalence to a claim that was never amended during prosecution. In each instance, the literal boundary of the claim is enlarged to prevent infringement by equivalent subject matter. In reality, the Federal Circuit limits the doctrine of equivalents far more than is actually necessary to balance the notice function of patent claims with the fundamental fairness of allowing patentees to assert their patent rights against infringers practicing mere equivalents of the literal claim scope. Under *Festo*, the pendulum swings so far in the direction of certainty that the beneficiaries are those seeking to free ride on claimed inventions, who now enjoy certainty that they are free to make an insubstantial change to a claim element amended during prosecution, and slavishly copy the remaining claim elements. In contrast, this Court struck the proper balance in *Warner-Jenkinson*, which held that the scope of prosecution history estoppel should be determined by an examination of the public record created by the patent applicant and the Patent Office during prosecution, thus providing the public with ample notice of what subject matter the patentee might have surrendered to obtain his claims.

The Federal Circuit in *Festo* rejects *Warner-Jenkinson*'s balanced approach to estoppel on the unsupported premise that it is "unworkable," a premise that is actually at odds with the widespread view of many in academia and industry (including the present *Amici Curiae*) that the patent system, including patent enforcement, has in fact been revitalized—in significant part because of the supportive role played by the Federal Circuit—and functions as an effective and efficient means of promoting and protecting innovation. Any decision to eviscerate the doctrine of equivalents is one that, if it is to be reached at all, should be reached by Congress.

III. Festo Unfairly Deprives Patent Owners Of Property Rights In Patents Already In Force.

The Federal Circuit's decision in *Festo* amounts in large part to retroactive legislation. As such, it results not only in unfairness, but also, in an important sense, a loss of due process. All of the patents now in force were prosecuted on the reasonable assumption that any narrowing amendments responding to rejections issued by the Patent Office would not automatically give rise to prosecution history estoppel barring ***all*** equivalents. This assumption, and its resulting effects on patent prosecution practice, was a product of reliance on long-standing Federal Circuit precedent, beginning with *Hughes Aircraft Co. v. United States*, 717 F.2d 1351 (Fed. Cir. 1983). The *Amici Curiae* and many others have relied upon this established rule of law in investing billions of dollars in research and development.

Thousands of patent license agreements are also in effect based on the same underlying understanding concerning the scope of equivalents afforded to patent rights. But now, in the absence of any legislative body conducting industrial policy analysis and providing a full opportunity for patent owners to present their views, the rules have been changed, both retroactively and prospectively.

In a very real sense, the issue is about the ownership of the intellectual property that lies just outside the literal claim language, and that is insubstantially different from it. Until *Festo*, this property right was owned by the inventor, or the inventor's assignee, because it was in substance part of his invention, unless application of the doctrine of equivalents would encroach on subject matter actually surrendered during prosecution or would ensnare prior art just outside the literal claim scope. Under *Festo*, however, the *Amici Curiae* and thousands of other patent owners have been stripped of this property right, since few existing patents have not had claims amended during the application process in the Patent Office. The property just outside the literal claim language will unfortunately always be free for the copyist, even when it is undisputedly equivalent to what is claimed, and thus flows directly from the patentee's contribution to the "Progress of Science and the Useful Arts." U.S. CONST., art. I, § 8, cl. 8.

IV. Festo Will Undermine The Future Effectiveness Of The Patent System To Incentivize And Protect Investments In Innovation.

Festo's impact on investment in innovation and on patent applications to be filed in the future is equally troublesome. Prior to *Festo*, the patent system encouraged investment in research that would lead to substantial improvements over previously patented technology. Developers recognized that insubstantially different products would likely be found to infringe others' patents. Post-*Festo*, insubstantial changes now can circumvent patent claims. All one needs to do to avoid a patent is to copy the patented invention but for a single insubstantial change in a feature described in an amended claim element. *See* 234 F.3d at 600-01 (Michel, J., concurring in part and dissenting in part). Motivation to achieve true innovation is diminished.

Moreover, in the post-*Festo* world, illogical results will confound patent drafters. The same claim limitation appearing in two claims may be accorded different effective scopes, if only one of the claims happened to be amended. Would-be patentees will be rewarded or punished based upon their ability to draft original claims that never require amendment.

In essence, the new rule requires patent applicants to do everything possible to avoid claim amendments during prosecution. As described in more detail by Petitioner (Petition for Writ of Certiorari at 25), the contentiousness, costs, and duration of patent prosecution are likely to increase dramatically if every narrowing claim amendment

results in an automatic and complete bar to the doctrine of equivalents.

The *Amici Curiae* regrettably recognize that the old give-and-take system between patent applicants and the Patent Office will be a thing of the past if *Festo* remains the law.[5] Rather than risking an equivalents-defeating estoppel, patent applicants will draw lines in the sand in their dealings with patent examiners, and, if they are unsuccessful in obtaining claims without amendments from the examiners, they will be forced to pursue appeals to the Patent Office's Board of Patent Appeals and Interferences. This will create a "new level of burden" for an already overburdened and underfunded Patent Office. Professor Janice M. Mueller, *quoted in* Victoria Slind-Flor, *Dying Doctrine of Equivalents*, THE NATIONAL LAW JOURNAL, Dec. 18, 2000 at B8. Today, the average pendency period for patent applications is 25 months, and the Patent Office has predicted that this period will expand to 38.6 months by 2006. *IPO Daily News*, May 2, 2001, *at* http://www.ipo.org. In addition, the backlog of the Board of Patent Appeals and Interferences is such that the average appeal lasts about two years.[6] An increase in Board appeals caused by the Federal Circuit's decision in *Festo* will,

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[5] This "give-and-take" was aptly described by Judge Newman in her separate opinion in *Litton Systems, Inc. v. Honeywell, Inc.*, 145 F.3d 1472, 1478-80 (Fed. Cir. 1998) (Newman, J., offering separate views in denying petition for rehearing on remand).

[6] *See* Tr. of 1999 Interference Roundtable at 6 (October 20, 1999), *at* http://www2.uspto.gov/web/offices/dcom/bpai/transcripts.html (The Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences reported an inventory of 8,344 appeals constituting "21.8 Board months of inventory.").

in all likelihood, simply overwhelm the Board's docket. Such delays will discourage investment in technology whose protection depends on the issuance of patent applications trapped in this administrative appellate limbo.

The impact of this sea change in patent prosecution practice cannot be overstated. Some patents will issue so long after development of the claimed technology that they will, for practical purposes, be obsolete. Since the delays will be caused by patent applicants' decisions to resist equivalents-defeating amendments, and therefore are not the fault of the Patent Office, applicants may lose portions of their full patent term, having spent long periods of their twenty-years-from-filing-date life engaged in contentious and protracted Patent Office proceedings. *See* 35 U.S.C. § 154. Ironically, the scope of many of these patents will be less certain under *Festo*. The reluctance to amend will result in fewer clarifying amendments responding to section 112 rejections, thus undercutting at least some of the certainty that motivated the Federal Circuit to impose the absolute rules of *Festo* in the first place. Finally, patent litigation may become more disruptive, as newly issued patents are asserted against established, but now suddenly infringing, uses of technology that arose during long periods of patent prosecution. Faced with increased patent prosecution costs, longer delays, and narrower patent protection to boot, companies will be tempted to maintain their inventions as trade secrets, rather than seeking patents. The result might be a loss of the public disclosure of technology that is such a valuable by-product of our patent system.

CONCLUSION

For the foregoing reasons *Amici Curiae* Minnesota Mining and Manufacturing Company; Bose Corporation; The Dow Chemical Company; Henkel Corporation; Johnson & Johnson; Pfizer Incorporated; PPG Industries, Incorporated; Sun Microsystems, Incorporated; Rexam Beverage Can Company; and Verizon Communications Incorporated respectfully request that the Petition for Writ of Certiorari be granted.

Respectfully submitted,

GARY L. GRISWOLD
Counsel of Record
MINNESOTA MINING AND MANUFACTURING CO.
P.O. Box 33427
St. Paul, MN 55133
(651) 733-8904

CHARLES HIEKEN
225 Franklin St.
Boston, MA 02110
Counsel for Bose Corp.

BRUCE M. KANUCH
GLENN H. KORFHAGE
THE DOW CHEMICAL CO.
2030 Dow Center
Midland, MI 48674

WAYNE C. JAESCHKE
HENKEL CORPORATION
2200 Renaissance Blvd.
Gulph Mills, PA 19406

PHILIP S. JOHNSON
JOHNSON & JOHNSON
One Johnson & Johnson Plaza
New Brunswick, NJ 08933

PETER C. RICHARDSON
LAWRENCE C. AKERS
PFIZER INCORPORATED
235 East 42nd Street
New York, NY 10017

JOHN K. WILLIAMSON
LINDA PINGITORE
PPG INDUSTRIES, INC.
One PPG Place
Pittsburgh, PA 15228

MARY J. SCHNURR
REXAM BEVERAGE CAN CO.
8770 W. Bryn Mawr Ave.
Chicago, IL 60631

SUN MICROSYSTEMS, INC.
901 San Antonio Rd.
Palo Alto, CA 94303

LEONARD C. SUCHYTA
VERIZON COMMUNICATIONS INCORPORATED
1095 Ave. of the Americas
New York, NY 10036